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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,667	01/05/2001	Yoshiaki Kumamoto	199314US3PCT	5630

22850 7590 06/16/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/16/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/673,667

Applicant(s)

KUMAMOTO ET AL.

Examiner

Christopher P Bruenjes

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation page.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 18.
10. ☒ Other: see continuation page

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**ADVISORY ACTION**

***Acknowledgement of Applicant's Amendments***

1. The amendments made in claims 1 and 17 given on pages 2-9 of Applicant's Amendment (Paper #20) have not been entered due to the fact that they raise new issues that would require further consideration and/or search. The limitation added to claims 1 and 17, wherein the top edge roughness is defined, raises new issue because further consideration is required to determine if the references already cited include the roughness defined for the body portion also on the top edge, and if new search is required.

***ANSWERS TO APPLICANT'S ARGUMENTS***

2. Applicant's arguments regarding the new added limitation of the roughness values for the top edge are not considered because the amendment has not been added to the claims.

3. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-3, 9, 13-19, 25-28, and 32 over Hicks in view of Stevens have been fully considered but are not persuasive.

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In response to applicant's argument that there is no basis in the teachings of Stevens or Hicks to combine, both Hicks and Stevens teach pulp-molded containers for storage of products. Stevens teaches that pulp-molded containers are optionally provided with thin sheet of plastic material on the inner or outer surface in order to make the container impervious to vapors and liquids. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, one of ordinary skill in the art would have recognized that depending on the product used in the container of Hicks or Stevens that a plastic material would be added to the inner surface or outer surface of the article, in order to provide a barrier layer for the product contained, as taught by Stevens.

4. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 4 and 20 over Hicks alone or in combination with Stevens in view of Kelley et al have been fully considered but are not persuasive.

In response to Applicant's argument that there is no basis in the teachings of Stevens or Hicks to combine with Kelley, all three references teach pulp-molded containers for storage of products. Kelley teaches that pulp-molded containers are optionally provided with thread on an opening portion in order to provide a connection for a threaded cap to be removably secured thereto. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, one of ordinary

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skill in the art would have recognized that the references taken as whole teach that pulp-molded containers are known to have threads on the opening portion in order to provide a strong connection for a removable lid or cap, as taught by Kelley.

5. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 5 and 21 over Hicks alone or in combination with Stevens in view of Utsul et al have been fully considered but are not persuasive.

In response to Applicant's argument that there is no basis in the teachings of Stevens or Hicks to combine with Utsul, all three references teach pulp-molded containers for storage of products. Utsul teaches that pulp-molded containers are made from pulp with a density that is at least  $0.3\text{g/cm}^3$ , in order to provide the container with excellent mechanical strength such as bending strength and stiffness, which one of ordinary skill in the art would recognize as beneficial properties for a container depending on the intended use of the container. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the

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modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971), references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, one of ordinary skill in the art would have recognized that the references taken as whole teach that pulp-molded containers are known to be formed with a density greater than  $0.3 \text{ g/cm}^3$  in order to provide the container with high bending strength and stiffness, which is beneficial depending on the intended use of the container, as taught by Utsul.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the

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organization where this application or proceeding is assigned  
are 703-872-9310 for regular communications and 703-872-9311 for  
After Final communications.

Any inquiry of a general nature or relating to the status  
of this application or proceeding should be directed to the  
receptionist whose telephone number is 703-308-0661.

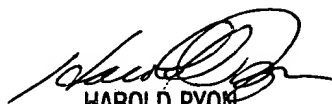
Christopher P Bruenjes

Examiner

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CPB

June 13, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1/11/2

6/13/03